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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,781

Applicant(s)

KLASSEN ET AL.

Examiner

JOHN HEFFINGTON

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 52-57, 64-84 and 94-111 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 52-57, 64-84 and 94-111 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-806)
Paper No(s) Mail Date 9/8/11, 9/16/11.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s) Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

This action is in response to the amendment dated 8 September 2011. Claims 70-76, 94, 103, 105, 106 and 108-111 have been amended. Claims 1-51 have been previously canceled and claims 58-63 and 85-93 have been canceled. Claims 52-57, 64-84 and 94-111 are pending and have been considered below.

Response to Arguments

1. Applicant's arguments filed 8 September 2011 have been fully considered but they are not persuasive.

The applicant argues that "As acknowledged by the Examiner, the cited portions of Wagner and Canfield fail, whether considered alone or in combination, to teach or suggest at least the claimed limitation of visually modifying a displayed icon to include a character representing a count of a plurality of different messaging correspondents from whom messages have been received. The cited references are concerned primarily with a number of new messages, without regard to the correspondents from whom the messages have been received, or the number of such correspondents from whom messages have been received and remain unread. The examiner respectfully disagrees. The cited passage of Canfield states "Once the new message is viewed or acknowledged, the indicator changes and the conversation counter 650 is updated to reflect one fewer message

waiting to be viewed. ... Although not shown in FIG. 6, either the conversation counter 650, the indicator, or both, may distinguish between a new message received from an ongoing IM session and new message received as part of the initiation of a new IM session." (paragraph 0054). The "conversation counter" of Canfield clear distinguishes new messages as part of an ongoing IM session from a new message received as part of the initiation of a new IM session, i.e. a message from a new correspondent. Canfield states that this feature is not shown in figure 6. In figure 6, the "conversation counter" shows only new messages. However, paragraph 0054 makes it clear that the "conversation counter" can show two different new message counts, new messages from an ongoing IM session, and a new messages from the initiation of new IM session. Since the new message is not from the correspondent involved in an ongoing IM session, the new message from a new IM session must be from a new different correspondent.

The applicant argues that "Canfield does not teach or suggest methods, devices, or other solutions suitable for implementation on wireless communications devices, such as mobile PDAs." The examiner respectfully disagrees. Canfield discloses " ... in another implementation, such devices [as a mobile telephone 192, a PDA 193] may themselves include the functionality of the general-purpose computer 170 and operate as the client device

120." (paragraph 0026). Canfield identifies mobile telephones and PDA as operating as the client devices in Canfield.

The applicant argues "With respect, (a) Canfield is not in the same field of invention as Applicant's claims; and (b) as Applicant and the Examiner have previously agreed with respect to Wagner, counting a number of new, unread messages is not the same as, or for present purposes analogous to, counting a number of correspondents from whom messages which remain unread have been received. To the extent that Canfield and Wagner teach counting of messages, they teach away from Applicant's claims." As shown above, Canfield discloses that mobile telephones and PDAs may function as client devices in Canfield. With respect Wagner and Canfield teaching away from each other, Wagner discloses "As such, the informational icon label 310 for the news service displays the business headline "Tech Markets Boom." Further, the text comprising each informational icon label 310 can be automatically updated as the state of that particular service changes as it applies to the particular user." (paragraph 0059). As shown, Wagner discloses an informational icon label that automatically updates as the state of the particular service changes. This is analogous to Canfield providing "an identifier, such as the screen name of the IM buddy, to identify the particular IM session to which it is assigned." (paragraph 0054).

The applicant argues that "The passages of Wagner cited by the Examiner suggest the display of various items, but are silent as to the possibility of any of them being concurrently displayed." The examiner respectfully disagrees. As shown in figure 6 of Canfield, the "conversation counter" is displayed concurrently with the number representing the number of IMs. Canfield also discloses "... either the conversation counter 650, the indicator, or both, may distinguish between a new message received from an ongoing IM session and new message received as part of the initiation of a new IM session." (paragraph 0054). The fact that the "conversation counter" or the indicator, each singularly, may distinguish a new message as part of an ongoing IM session from a new message received as part of the initiation of a new IM session clearly suggests that the indications of the new message as part of an ongoing IM session is displayed concurrently with indication of the new message received as part of the initiation of a new IM session.

The applicant argues that "Moreover, it is not at all clear that Wagner is suggesting the display of an identifier of a correspondent from whom a message has been received in conjunction with an application icon; and no such thing is taught in an enabling way." The examiner respectfully disagrees. Since the "conversation counter" show the counts of IM messages, the "conversation counter" must be shown in conjunction with an IM application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 52-75, 83, 84, 92, 93, 101, 102, 110, 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US 2004/0155908 A1) in view of Canfield et al. (US 2004/0056893 A1).

1 - 51. (Cancelled)

Claim 52. Wagner discloses a method of providing notifications of unread messages on a wireless communication device (paragraph 0003 [This invention relates

generally to mobile devices, and more particularly to software and systems for user interfaces on mobile devices.)), comprising: displaying at least one icon relating to electronic messaging on a graphical user interface of the wireless communication device; receiving a plurality of electronic messages on the wireless communication device, the plurality of electronic messages including messages from a plurality of different messaging correspondents (paragraph 0064 [For example in FIG. 5A, the mobile device displays a ski service 502, a news service 504, a buddies service 506, a messaging service 508, ...], paragraph 0060 [As another example, a mail icon may display a counter that changes to indicate the number of unread messages a user has.], figure 3).

Wagner does not disclose in response to receiving at least one of the plurality of electronic messages, visually modifying at least one displayed icon relating to electronic messaging to include a numeric character representing a count of the plurality of different messaging correspondents for which one or more of the electronic messages have been received and remain unread, as disclosed in the claims. However, in the same field of invention, Canfield discloses " ... in another implementation, such devices [as a mobile telephone 192, a PDA 193] may themselves include the functionality of the general-purpose computer 170 and operate as the client device 120." (paragraph 0026) and "Once the new message is viewed or acknowledged, the indicator

changes and the conversation counter 650 is updated to reflect one fewer message waiting to be viewed. ... Although not shown in FIG. 6, either the conversation counter 650, the indicator, or both, may distinguish between a new message received from an ongoing IM session and new message received as part of the initiation of a new IM session." (paragraph 0054). Therefore, considering the teachings of Wagner and Canfield, it would have been obvious to one having ordinary skill in the art at the time of the invention to add in response to receiving at least one of the plurality of electronic messages, visually modifying at least one displayed icon relating to electronic messaging to include a numeric character representing a count of the plurality of different messaging correspondents for which one or more of the electronic messages have been received and remain unread to the teachings of Wagner. One would have been motivated to add in response to receiving at least one of the plurality of electronic messages, visually modifying at least one displayed icon relating to electronic messaging to include a numeric character representing a count of the plurality of different messaging correspondents for which one or more of the electronic messages have been received and remain unread to the teachings of Wagner in order to provide the user with comprehensive statistics regarding concurrent messaging sessions (Canfield: paragraph 0052).

Claim 53: Wagner and Canfield disclose the method of claim 52, and Wagner further discloses displaying a plurality of icons including one or more application icons that are

selectable to invoke respective ones of a plurality of applications on the wireless communication device (paragraph 0056 [The context-based display 300 presents services and applications to users utilizing icons. In the example of FIG. 3, the icons are displayed in various locations on the context-based display 300 dependent on predicted usage.], figure 3).

Claim 54. Wagner and Canfield disclose the method of claim 53, and Canfield further discloses visually modifying one or more of the plurality of icons to include a count of electronic messages that have been received and remain unread, as disclosed in the claims (paragraph 0026 [... in another implementation, such devices [as a mobile telephone 192, a PDA 193] may themselves include the functionality of the general-purpose computer 170 and operate as the client device 120."]). Therefore, considering the teachings of Wagner and Canfield, it would have been obvious to one having ordinary skill in the art at the time of the invention to add visually modifying one or more of the plurality of icons to include a count of electronic messages that have been received and remain unread to the teachings of Wagner and Canfield. One would have been motivated to add visually modifying one or more of the plurality of icons to include a count of electronic messages that have been received and remain unread to the teachings of Wagner and Canfield in order to provide the user with comprehensive statistics regarding concurrent messaging sessions (Canfield: paragraph 0052).

Claim 55. Wagner and Canfield disclose the method of claim 52, and Wagner further discloses the at least one icon relating to electronic messaging being selectable to invoke an electronic messaging application (paragraphs 0060, [To further assist the user in service and application selection, embodiments of the present invention animate particular icons to indicate additional information regarding the particular service or application that the icon represents.], 0065, [In the example of FIG. 5A the user decides to view the news by selecting the news data service 504.]).

Claim 56. Wagner and Canfield disclose the method of claim 52 and Wagner further discloses displaying on the graphical user interface an identifier of the correspondent from whom at least one of the plurality of messages was received (paragraph 0080 [Then, for example, Bob may call the user and leave a voice mail for the user. In this example, the user action proxy 612 will notice that Bob is a common theme within the services and applications, and as such, may send the user an alert indicating something important may be occurring regarding Bob.]).

Claim 57. Wagner and Canfield disclose the method of claim 52, and Wagner further discloses displaying on the graphical user interface at least one preview of content

associated with at least one of the received electronic messages (paragraph 0060 [Then, to indicate new news has arrived, the news icon may animate to display an "unrolled" newspaper.], figure 3).

Claims 58-63 Canceled.

Claim 64-69 disclose a computer-readable memory accessible by a processor of a wireless communication device, the memory comprising stored electronic data structures representing executable instructions similar to the method of claims 52-57 and are rejected with the same rational.

Claims 70-75 disclose a wireless communication device comprising: a processor; a display electrically coupled to the processor, the display presenting a graphical user interface; and a memory storing machine-readable instructions executable by the processor similar to the method claims 52-57 and are rejected with the same rational.

Claim 76. Wagner discloses a method of providing notifications of unread messages on a wireless communication device (paragraph 0003 [This invention relates generally to mobile devices, and more particularly to software and systems for user interfaces on mobile devices.]), comprising:

- a. displaying at least one icon relating to an electronic messaging application on a graphical user interface of the wireless communication device; receiving on the

wireless communication device a plurality of electronic messages associated with the electronic messaging application; and responsive to receiving at least one of the plurality of electronic messages: visually modifying at least one icon relating to the electronic messaging application to include a count of the plurality of electronic messages which remain unread (paragraph 0064 [For example in FIG. 5A, the mobile device displays a ski service 502, a news service 504, a buddies service 506, a messaging service 508, ...], paragraph 0060 [As another example, a mail icon may display a counter that changes to indicate the number of unread messages a user has.], figure 3); and

- b. displaying on the graphical user interface a text identifier associated with a correspondent from whom the at least one of the plurality of electronic messages was received (paragraph 0059 [Further, the text comprising each informational icon label 310 can be automatically updated as the state of that particular service changes as it applies to the particular user.], paragraph 0080 [Then, for example, Bob may call the user and leave a voice mail for the user. In this example, the user action proxy 612 will notice that Bob is a common theme within the services and applications, and as such, may send the user an alert indicating something important may be occurring regarding Bob.]).

Wagner does not disclose displaying on the graphical user interface concurrently with the visually-modified icon a text identifier, as disclosed in the claims. However, in the same field of invention, Canfield discloses "The tear-off elements 522 and 622 include a status indicator (e.g., 622a2, 622b2, 622d2, 622h2) to indicate whether a new IM message within the IM session corresponding to an interface tear-off element remains pending for review. In general, the indicator provides a perceivable status indication to the user that a new message is pending in at least one concurrent instant messaging session. Once the new message is viewed or acknowledged, the indicator changes and the conversation counter 650 is updated to reflect one fewer message waiting to be viewed. The tear-off elements 522 and 622 also may include an identifier, such as the screen name of the IM buddy, to identify the particular IM session to which it is assigned." (paragraph 0054). Therefore, considering the teachings of Wagner and Canfield, it would have been obvious to one having ordinary skill in the art at the time of the invention to add displaying on the graphical user interface concurrently with the visually-modified icon a text identifier to the teachings of Wagner. One would have been motivated to add displaying on the graphical user interface concurrently with the visually-modified icon a text identifier to the teachings of Wagner in order to assist the user in service and application selection (Wagner: paragraph 0059 [In addition to

using positional data to assist the user in service and application selection, the service management system also provides informational icon labels 310.)).

Claim 77. Wagner and Canfield disclose the method of claim 76, and Wagner further discloses the identifier associated with a correspondent from whom the at least one of the plurality of electronic messages was received comprising state information pertaining to the correspondent (paragraph 0059 [Further, the text comprising each informational icon label 310 can be automatically updated as the state of that particular service changes as it applies to the particular user.]).

Claim 78. Wagner and Canfield disclose the method of claim 76, and Wagner further discloses displaying on the graphical user interface at least a preview of content associated with at least one of the received electronic messages (paragraph 0060 [Then, to indicate new news has arrived, the news icon may animate to display an "unrolled" newspaper.], figure 3).

Claim 79. Wagner and Canfield disclose the method of claim 76, and Wagner further discloses displaying on the graphical user interface for a predetermined period of time at least a preview of content associated with at least one of the received electronic messages (paragraph 0060 [Then, to indicate new news has arrived, the

news icon may animate to display an "unrolled" newspaper.], figure 3).

Claim 80. Wagner and Canfield disclose the method of claim 76, and Wagner further discloses the at least one icon relating to electronic messaging being selectable to invoke an electronic messaging application (paragraphs 0060, [To further assist the user in service and application selection, embodiments of the present invention animate particular icons to indicate additional information regarding the particular service or application that the icon represents.], 0065, [In the example of FIG. 5A the user decides to view the news by selecting the news data service 504.]).

Claim 81. Wagner and Canfield disclose the method of claim 80, and Wagner further discloses, responsive to invoking the electronic messaging application, navigating automatically to a graphical user interface comprising content associated with at least one of the received electronic messages (paragraphs 0060, [To further assist the user in service and application selection, embodiments of the present invention animate particular icons to indicate additional information regarding the particular service or application that the icon represents.], 0065, [In the example of FIG. 5A the user decides to view the news by selecting the news

data service 504.)).

Claim 82. Wagner and Canfield disclose the method of claim 80, and Wagner further discloses responsive to invoking the electronic messaging application within a predetermined time following receipt of at least one of the received electronic messages, navigating automatically to a graphical user interface comprising content associated with the at least one of the received electronic messages (paragraphs 0060, [To further assist the user in service and application selection, embodiments of the present invention animate particular icons to indicate additional information regarding the particular service or application that the icon represents.], 0065, [In the example of FIG. 5A the user decides to view the news by selecting the news data service 504.])).

Claim 83. Wagner and Canfield disclose the method of claim 80, but Wagner does not disclose responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to include a decreased count of electronic messages which remain unread, as disclosed in the claims.

However, in the same field of invention, Canfield discloses "Once the new message is viewed or acknowledged, the indicator changes and the conversation counter 650 is updated to reflect one fewer message waiting to be viewed." (paragraph 0054), and "Conversation counter 650

may be updated to show that are no new IM messages waiting to be viewed." (paragraph 0059). Therefore, considering the teachings of Wagner and Canfield, it would have been obvious to one having ordinary skill in the art at the time of the invention to add responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to include a decreased count of electronic messages which remain unread to the teachings of Wagner and Canfield. One would have been motivated to add responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to include a decreased count of electronic messages which remain unread to the teachings of Wagner and Canfield in order to keep an accurate count of unread messages so the user is not misled about the number of unread messages after one or more messages have been read.

Claim 84. Wagner and Canfield disclose the method of claim 80, but Wagner does not disclose responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to remove the count of electronic messages which remain unread, as disclosed in the claims. However, in the same field of invention, Canfield discloses "Once the new message is viewed or acknowledged, the indicator changes and the conversation counter 650 is updated to reflect one fewer message waiting to be viewed." (paragraph 0054), and "Conversation counter 650 may be updated to show that are no new IM messages waiting to be viewed."

(paragraph 0059). Therefore, considering the teachings of Wagner and Canfield, it would have been obvious to one having ordinary skill in the art at the time of the invention to add responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to remove the count of electronic messages which remain unread to the teachings of Wagner and Canfield. One would have been motivated to add responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to remove the count of electronic messages which remain unread to the teachings of Wagner and Canfield in order to keep an accurate count of unread messages so the user is not mislead about the number of unread messages after one or more messages have been read.

Claims 85-93 Canceled.

Claims 94-100 disclose a computer-readable memory accessible by a processor of a wireless communication device, the memory comprising stored electronic data structures representing executable instructions which similar to the method of claims 76- 82 and are rejected with the same rational.

Claims 101-102 disclose a computer-readable memory accessible by a processor of a wireless communication device, the memory comprising stored electronic data

structures representing executable instructions which similar to the method of claims 83-84 and are rejected with the same rational.

Claims 103-109 disclose a wireless communication device comprising: a processor; a display electrically coupled to the processor, the display presenting a graphical user interface; and a medium or media including machine-readable instructions executable by the processor similar to the method claims 76-82 and are rejected with the same rational.

Claims 110-111 disclose a wireless communication device comprising: a processor; a display electrically coupled to the processor, the display presenting a graphical user interface; and a medium or media including machine-readable instructions executable by the processor similar to the method claims 83-84 and are rejected with the same rational.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN HEFFINGTON whose telephone number is (571)270-1696. The examiner can normally be reached on 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boris M. Pesin can be reached on 571-272-4070. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMH

10/19/11

/Boris Pesin/

Supervisory Patent Examiner, Art Unit 2172